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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/895,936	07/17/1997	RICHARD WISNEIEWSKI	17882706	1542

7590

06/16/2003

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EXAMINER

FORD, JOHN K

ART UNIT	PAPER NUMBER
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3743

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DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

The reply filed on March 5, 2003 (Paper No. 35) is not fully responsive to the prior Office Action because of the following omission(s) or matter(s) detailed below.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Applicant Wisniewski has asserted under the penalty of perjury that the first two paragraphs under the description of Prior art section on page 2 of the specification refer to the 1992 Genentech device disclosed in the 1992 Wisniewski and Wu publication. This particular description in the specification suggest that the prior art is much broader than is disclosed in the afore mentioned publication, including, for example, that fins are attached to the container wall. There is no such disclosure in the 1992 Wisniewski and Wu publication. Mr. Wisniewski's second declaration fails to even address this discrepancy between the conceded prior art in the specification and the 1992 Wisniewski and Wu publication. Please contact Mr. Wu and Mr. Wisniewski and have them execute a joint declaration explaining this important discrepancy. While one inventor of a larger inventive entity may have certain knowledge of the prior art it is not necessarily the case that he is cognizant of the prior art known to the other inventors. It is respectfully submitted that in many real world situations one inventor can rarely speak for all the rest in these particular situations. Again, if there is prior art known to either of

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them, which discloses fins attached to the wall of the container, it must be disclosed to the Examiner. If there is none, then both inventors must so state and explain how the statements made in the specification were overlooked in the pre-filing reviews.

In paragraph 9 of Mr. Wisniewski's second declaration he states the prior art described in the third paragraph on page 2 of the specification corresponds to USP 2,129,572 and USP 2,441,376. This is not possible in the examiner's opinion because at the time the specification was written Mr. Wisniewski did not know of the existence of either of these patents, which were cited to him years later by an overseas search and the current Examiner. In other words, it is submitted that USP '572 and USP '376 could not have been the prior art references applicants Wisniewski and Wu were describing in the specification because they did not yet know of their existence. Had they known of their existence at the time of filing, they would have been cited as prior art to the Examiner in a PTO – 1449 and they were not.

Again, no publication or carefully drawn sketch with meaningful legends of the prior art disclosed on page 2 of the specification have been provided. No disclosure of what processes and what fluids have been processed in the prior art disclosed on page 2 of the specification have been provided. Both of these were required in the previous office action.

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Applicant's recollection of the early interview with either Examiner Chandler or Pryor is somewhat disappointing, but accepted. The 1992 article, Mr. Wisniewski discusses, was presented to Examiner Ford and SPE Lazarus at a later interview than the one the Examiner inquired about. The prior art that this examiner is interested in was apparently shown to SPE Lazarus and either Examiner Chandler or Pryor at a much earlier interview (e.g. March 1, 1999). In fact, in Paper No. 11 (amendment of March 22, 1999) it states, "During the interview, Mr. Wisniewski discussed the background of the technology surrounding the present invention". It is SPE Lazarus's recollection that prior art beyond that of record was discussed. Unfortunately, neither Examiners Pryor nor Chandler is employed at the PTO any longer, and Mr. Lazarus remembers little.

Moreover, the Examiner asked what liquids were processed in the prior art discussed on page 2 of the specification, not what liquids were processed in USP '376 and USP '572.

Finally, the Examiner does recall an informal telephone call with Mr. Mesiti regarding what precisely the Examiner was looking for in the way of prior art and the Examiner recalls suggesting that applicant contact patent or general counsel at Genentech and ask for permission to measure the sizes of the fins, (height and width) and diameter of the tank and distance between the wall and tip of fin of the Genentech device, if it still exists, explaining that it had been made public via the 1992 publication.

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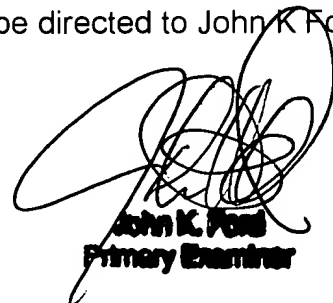
If counsels for Genentech refused, the inquiry could end there with a statement on the record documenting exactly what efforts had been made to ascertain this critical information. If permission was granted applicant was requested to go measure it and provide a meaningful sketch with dimensions.

The current record is devoid of any evidence that applicant or counsel have expended any effort to ascertain this information from Genentech.

While applicant states for the first time that the distance between the top of the fin and container wall was "greater than 4 inches " (a somewhat surprising statement given all of the previous requests that the Examiner has made for this information which have been met with silence) he does not state why he cannot recollect any other dimension.

The declaration also does not state if Mr. Wu recollected any of this information. Perhaps he has a better memory or documents. Again a phone call to Mr. Wu would not seem to be an unreasonable request to make under the circumstances. Please put into the record the results of the inquiry to Mr. Wu.

Any inquiry concerning this communication should be directed to John K Ford at telephone number 703-308-2636.



John K. Ford
Primary Examiner